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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/217,595	12/22/98	LANIER	J 5181-10802

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LM02/0621

EXAMINER

TREAT, W

ART UNIT	PAPER NUMBER
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2783

1A

DATE MAILED:

06/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/27,595

Applicant(s)

Lanier et al.

Examiner

W. TREAT

Group Art Unit

2763

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 (three) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/4/00.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-94 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-94 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. Claims 1-94 are presented for examination.
2. Claims 1-94 are rejected under 35 U.S.C. 251 as being drawn to subject matter voluntarily given up by applicants in order to obtain a patent.
3. A reissue will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1989); In re Wadlinger, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); In re Richman, 409 F.2d 269, 276, 161 USPQ 359, 363-64 (CCPA 1969); In re Willingham, 282 F.2d 353, 127 USPQ 211 (CCPA 1960). The Federal Circuit stated the following principles in Clement: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. See MPEP § 1412.03 as to broadening claims
4. Applicants' independent claims 31, 66, 72, 77, and 90 and their dependents as well as amended claim 94 are an attempt to recapture subject matter of independent claims 1, 26 and 30

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which was deliberately amended (i.e. canceled) by applicants following a rejection by the examiner based on prior art. Even though applicants' claims might be viewed as narrower in an aspect of the claims unrelated to the prior art rejection they are broader in aspects germane to the prior art rejection. For instance, when applicants use words such as "emulate the first body..." and emulate the second body..." these words are directed to the same aspect of applicants' invention as the "first body emulating means..." and second body emulating means..." described in a far more limiting manner following amendment of claim 1 after the examiner's prior art rejection. Also, applicants' switch from means plus function language to describe sensing and integrating aspects of applicants' invention to broader terms is also viewed as an attempt to recapture. Applicants' new claims 90-94 are also broader in aspects germane to the prior art rejection.

5. Applicants' mistakes of a typographical or clerical nature were more appropriate to a Certificate of Correction than a reissue application.

6. Claims 1-30 will not become allowable unless applicants amend the new independent claims so that they are commensurate in scope with all aspects of the appropriate, previously allowed independent claims before further amending the claims to correct for any failure to file, for example, for a software program on a computer-readable medium. Should applicants merely cancel their new claims or fail to present allowable claims which correct errors other than those of a typographical or clerical nature they will have failed to demonstrate an error meriting reissue and all claims will stand rejected.

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7. Applicants have argued that deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claims before cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary. However, there is no evidence in the prosecution history to the contrary thereby rendering the point moot.

8. Applicants have also argued a patentee may obtain on reissue a claim that varies materially from the claims originally surrendered even though it omits a limitation intentionally added to obtain issuance of the patent. What applicant has done is omit **many intentionally added** limitations while making trivial modifications of limitations already recited in or inherently present in independent claims 1, 26 and 30. It is abundantly clear to one of ordinary skill in the art communications are taking place among the elements of claims 1, 26, and 30. A mere recitation of conventional means of communication at the time of applicants' invention as in claims 36 and 37 is neither material nor patentable differentiation. Recitation of types of virtual objects which might be manipulated as in claim 44 is trivial modification of limitations present in original dependent claims 7 and 8 which failed to provide patentable differentiation. The limitations of claim 68 are found in original dependent claim 23 which failed to provide patentable differentiation. The elements of claim 69 were already inherently present given the use of body part sensing means as the claim language.

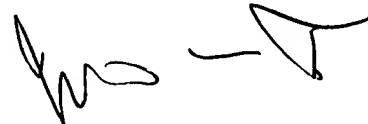
9. Applicant's arguments filed 5/4/00 have been fully considered but they are not persuasive.

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10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication should be directed to William M. Treat at telephone number (703) 305-9699.



**WILLIAM M. TREAT
PRIMARY EXAMINER**